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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,252	04/12/2001	Regine Helibronn	100564-00044	5869
6449	7590	07/05/2005	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			GUZO, DAVID	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b><i>Advisory Action Before the Filing of an Appeal Brief</i></b>	<b>Application No.</b> 09/720,252	<b>Applicant(s)</b> HELIBRONN, REGINE	
	<b>Examiner</b> David Guzo	<b>Art Unit</b> 1636	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 June 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 61-79.

Claim(s) withdrawn from consideration: 60.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Given the non-entry of the proposed amendment filed 6/20/05, applicant's arguments based upon entry of said amendments are moot. With regard to applicant's arguments concerning the deposit issues for HSV strain 1802, it is noted that applicant's proposed amendment to claim 69 broadens the scope of the claim to recite any derivative of strain 1802 and therefore a deposit of the strain would not satisfy the requirements of 112, 1<sup>st</sup> paragraph, since applicant has not disclosed "derivatives" of the claimed strain. With regard to applicant's arguments traversing the outstanding 102(b) rejection over Dong et al., applicant does not present sufficiently new or convincing arguments sufficient to overcome the rejection. With regard to the outstanding 103(a) rejection over Dong et al. in view of Dargan et al., applicant's arguments are primarily based upon the alleged deficiencies of the Dong et al. reference under 35 USC 102. These arguments have been previously addressed by the examiner in the previous Office Action. With regard to applicant's assertion that Dargan et al. teaches away from the instant invention in that Dargan et al. teaches mutation of the UL9 gene rather than deletion of the UL9 gene, this is not persuasive. Inactivation of the UL9 gene is achieved in both cases, whether by mutation or deletion. It is unclear how Dargan et al. teaches away from the claimed invention in that both Dargan et al. and the instant invention both inactivate the well known essential HSV UL9 gene.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).

13. ☐ Other: \_\_\_\_\_

*David Guzo*  
 DAVID GUZO  
 PRIMARY EXAMINER

U.S. Patent and Trademark Office  
PTOL-303 (Rev. 4-05)

**Advisory Action Before the Filing of an Appeal Brief**

Part of Paper No. 2

Continuation of 3. NOTE: Applicant's proposed amendments to the claims deleting reference to an "expression vector" integrated into a non-essential part of the rHV genome and substituting a "expression cassette"; applicant's amendment limiting the titers of the rHV to being "up to or greater than 20%"; applicant's amendment to claim 69 reciting that the rHSV is a recombinant "derivative of" HSV-1 strain 1802 and applicant's amendment reciting the number of dilution steps in a plaque assay all raise issues which would require further search and/or consideration. For example, the metes and bounds of what a "derivative" of HSV-1 strain 1802 encompasses are unclear. While it is noted that many of the amendments proposed by applicant were suggested by the examiner in the previous Office Action, their entry at this late stage in prosecution (after a Final rejection) would raise new issues requiring further search and consideration because these limitations have not been previously claimed. It is noted that prosecution is CLOSED after a Final rejection.